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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YUUJI SAIKI, MASAYUKI SATAKE,
YASUSHI TAKAHASHI, and TAKASHI SHOUDA

Appeal 2009-001931
Application 10/015,991
Technology Center 2800

Decided:¹ June 30, 2009

Before, CATHERINE Q. TIMM, BEVERLY A. FRANKLIN, and
JEFFREY B. ROBERTSON, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the Decided Date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-4, 9, 10, and 27-28. We have jurisdiction under 35 U.S.C. § 6(b).

Claims 1 and 4 are representative of the subject matter on appeal and are set forth below:

1. An optical member in which a surface of an optical material is bonded to and covered with a transparent protective film having an outer surface roughness Ra of from 0.03 to 1 μm that does not substantially alter the transparent properties of the protective film, wherein the protective film comprises a protective base and an adhesive layer disposed on the protective base so that the protective base can be released together with the adhesive layer from the optical material.

4. The optical member according to claim 1, wherein the optical material comprises a polarizing plate, and at least one of a retardation plate and a brightness enhancement plate.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Murata	5,886,819	Mar. 23, 1999
Iwata	6,111,699	Aug. 29, 2000
Nagahama	WO 00/44841	Aug. 03, 2000

SUMMARY OF THE DECISION

We affirm.

THE REJECTIONS

Claims 1-3, 9-10, and 27-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagahama in view of Murata.

Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagahama in view of Murata as applied to Claim 1 above, and further in view of Iwata.

ISSUE

Have Appellants shown that the Examiner reversibly erred in rejecting the claims by convincingly showing that the combination of references lacks sufficient motivation to combine?

FINDINGS OF FACT

We refer to the Examiner's findings regarding the teachings of Nagahama made on pages 3-4. Appellants do not dispute these findings.

We refer to the Examiner's findings regarding the teachings of Murata made on page 4 of the Answer. Appellants do not dispute these findings.

It is not necessary to address the Iwata reference in making the determinations herein.

PRINCIPLES OF LAW

One cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 642 F.2d 413, 425-426 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097-1098 (Fed. Cir. 1986).

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined

teachings of the references would have suggested to those of ordinary skill in the art. *See Keller*, 642 F.2d at 425.

“When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007).

ANALYSIS

1. The Rejection of claims 1-3, 9-10, 27-28 under 35 U.S.C. § 103(a) as being unpatentable over Nagahama in view of Murata.

Appellants argue that the antiglare film of Murata is integral with the polarizer of the optical member which is integrated into the display of Murata. Br. 4-5. Appellants argue that thus the antiglare film of Murata is not used temporarily for protection of an optical member during transportation and storage, but is permanently attached to the adjacent optical layer. Br. 4-5. Appellants also argue that Murata provides no incentive to add antiglare properties to a temporary protective film of Nagahama. Br. 5. Appellants also argue that Murata seeks to improve antiglare properties in a display and not in a film, and evaluates the antiglare properties in a display exclusively. Br. 5-7.

We are not convinced by the above-mentioned arguments. As stated by the Examiner on page 8 of the Answer, one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. *Keller*, 642 F.2d at 425-426; *In re Merck & Co., Inc.*, 800 F.2d at 1097-1098. In the instant case, the Examiner finds

(and Appellants do not dispute) that Nagahama teaches the aspect of Appellants' claimed subject matter directed to a protective film comprising a protective base and an adhesive layer so that the protective base can be released together with the adhesive layer from an optical material. Ans. 3.

The Examiner relies upon Murata for teaching the aspect of Appellants' claimed subject matter directed to a protective film being transparent and having an outer surface roughness Ra from 0.03 to 1 μm .

We are in complete agreement with the Examiner's reasoning on pages 4-5 and 7 of the Answer, that one of ordinary skill in the art would have been motivated to incorporate these teachings of Murata into the structure of Nagahama "to ease or simplify inspection of the underlying attached optical material (e.g. polarizer element) due to a relatively higher contrast, while reducing or eliminating possible glittering effects during viewing." Nagahama expresses the desire to allow for inspection of display ability, hue and contrast without the hindrance of a two step process. Nagahama, 5-6. Murata addresses the antiglare effect. Murata, col. 3, beginning at l. 37. The combination of references therefore supports the Examiner's position. Furthermore, "[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability." *KSR* at 417.

In view of the above, we affirm the rejection of claims 1-3, 9-10, and 27-28 under 35 U.S.C. § 103(a) as being unpatentable over Nagahama in view of Murata.

2. The Rejection of claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Nagahama in view of Murata as applied to Claim 1 above, and further in view of Iwata.

On page 8 of the Brief, Appellants repeat similar arguments for this rejection. Hence, for the same reasons that we affirmed the previous rejection, we also affirm the rejection of claim 4.

CONCLUSIONS OF LAW

Appellants have not shown that the Examiner erred in rejecting the claims because Appellants have not convincingly shown that the combination of references lacks sufficient motivation to combine.

DECISION

Each of the rejections is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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